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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,391	06/25/2001	Jacoba Adriana De Ronde	1930-A-PCT	9219

7590

10/04/2002

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EXAMINER

HELMER, GEORGIA L

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/807,391

Applicant(s)

DE RONDE ET AL.

Examiner

Georgia L. Helmer

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.5
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-22 are pending and are examined in the instant application.
2. The effective filing date for this case is the PCT filing date, 14 October 1999.  
Benefit of foreign priority requires that the priority document be submitted.

### ***Specification***

3. Applicant is required to update the status (pending, allowed, etc.) of all relevant parent priority applications in the first line of the specification. The status of all citations of US filed applications in the specification should also be updated where appropriate.
4. The Office acknowledges receipt of Amendments dated 4 June 2001, paper No. 3, and dated 25 June 2001, paper No 7.
5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Information Disclosure Statement***

6. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 3 is attached to the instant Office action.

***Claim Rejections - 35 USC § 112, second paragraph***

7. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, where is the "gene"? In order to "transform", a polynucleotide of interest is required. Also, do "transform" and "genetically modify" have the same meaning? Or are these alternatives?

In all dependent claims, "A" should be changed to "The".

In claims 5, 6, and 7, "are" should be changed to "is", "they" to "it".

Claims which recite "gene" are unclear because a "gene" implies a DNA sequence that exists in nature and includes coding and noncoding regions, as well as all regulatory sequences associated with expression. Since this does not appear to be Applicant's intention, the language "a DNA of interest" is suggested. Or Applicant may recite the various components of the "gene" desired.

In claim 10, delete "one of ", and change "and" to "or".

In claim 14, "at least one of " implies other Markush species which are unspecified. This is improper use of Markush language.

In claim 15, the Family name is capitalized.

In claim 20, amend "cultivated" to "obtained" because it is unclear what "cultivated " involves.

Clarification and/or correction are required.

***Claim Rejections - 35 USC § 112, first paragraph-written description***

8. Claims 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed invention lacks written description under current written description guidelines. The claims are drawn to progeny plants having undisclosed identifying characteristics whereby only one parent in the first cross is known, and none of the parents in any of the subsequent crosses are known. Applicant should note that no identifying characteristics are set for the F1 progeny. If the claimed F1 plant itself cannot be identified by characteristics clearly disclosed in the specification, then it is not even possible to determine whether a plant of unknown parentage is or is not covered by the claim. Thus, F1 progeny plants that are not disclosed by any identifying characteristics are not considered to be possessed by Applicant. There is insufficient relevant identifying characteristics to allow one skilled in the art to predictably determine that genomic structure or phenotypic characteristics of the plant obtained at each level of crossing or at each generation, absent further guidance. The breeding techniques disclosed encompass conventional cross hybridization using two parent plants that are genetically distinct from each other. Each of these breeding techniques would result in a structurally and phenotypically different plant. Over an undetermined number of generations, the identifying characteristics for each generation become highly

unpredictable, especially in view of the fact that none of the identifying characteristics of the progeny plants are disclosed in the specification or set forth in the claims.

Accordingly, there is a lack of adequate description for the claimed progeny plants, and in view of the level of knowledge and skill in the art, one skilled in the art would not recognize from the disclosure that Applicant was in possession of the claimed invention at the time of filing. Accordingly, the claimed invention lacks adequate written description under current written description guidelines. (See, Written Description Examination Guidelines (published in Federal Registry/Vol. 66, No.4/Friday, January 5, 2001/Notices: p. 1099-1111)).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5, 7-9, 12, 13, 14, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Clough et al, 1998, Plant Journal, Vol 16, No. 6, pages 735-743.

(Applicant's IDS)

Clough teaches a method of obtaining transformed seed by contacting germinating plant seed with a wetting agent and Agrobacterium (Summary, p 735), an Agrobacterium and wetting agent admixture (Figure 2, p 738, and Table 3, p 739), vacuum infiltration (Table 1, p737), a contact period of 24 hours, and a temperature of 24 degrees C, Agrobacterium tumefaciens (Abstract), a foreign

gene comprising a resistance gene (p 741, 1<sup>st</sup> column, last sentence), plant seed, plants, and progeny (Table 3, p 739).

Accordingly Clough anticipates the claimed invention.

11. Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett, US 5, 658, 773, issued 19 August 1997.

Bennett teaches a method transformation using *Agrobacterium* (col 8, lines 47-65), use of a wetting agent and a seed (col 14, line 57) and legumes (col 9, lines 43-46).

Accordingly Bennett anticipates the claimed invention.

#### **Remarks**

12. No claim is allowed.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

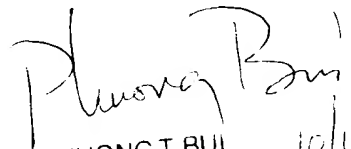
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia Helmer PhD  
Patent Examiner, Art Unit 1638  
October 1, 2002

  
PHUONG T. BUI  
PRIMARY EXAMINER 10/1/02